REMARKS

In the final Office Action dated November 14, 2003, claim 39 was objected to; claims 1, 2, 5, 29, 34, 38, 39, and 43 were rejected under 35 U.S.C. § 102 over Culpepper, "SIP INFO Method for Event Reporting," draft-culpepper-sip-info-event-00.txt (April 2000); claims 9-12, 18-21, 24, 25, 28, 35, 36, and 40-42 were rejected under § 103 over Culpepper in view of Choudhuri, "SIP INFO Method for DTMF Digit Transport and Collection," draft-choudhuri-sip-info-digit-00.txt (April 2000); claims 13 and 23 were rejected under § 103 over Culpepper in view of Choudhuri and Media Gateway Control Protocol (MGCP), Version 1.0 (hereinafter "MGCP"); claims 3 and 30 were rejected under § 103 over Culpepper in view of MGCP; claims 4, 6-8, 14-17, 22, 26, and 27 were rejected under § 103 over Culpepper in view of Choudhuri, MGCP, and Bearer Independent Call Protocol (BICP) ITU Recommendation Q.1901; and claims 31-33, 37, and 44 were rejected under § 103 over Culpepper in view of BICP.

Claim 39 has been amended to address the typographical error. No change in the claim scope has been effected by this amendment.

Claim 1 recites receiving a call request from a first media gateway controller to a second media gateway controller over a network, requesting information from the first media gateway controller, and receiving the information *before establishing a bearer path over the network.*

Culpepper, on the other hand, describes the use of the SIP INFO method for communicating *mid-call* events in SIP sessions. Culpepper at 1. Culpepper also mentions the use of the SIP INFO method for carrying *mid-session* signaling messages. *Id.* Therefore, it is clear that Culpepper relates to using a SIP INFO message to communicate information *after* a bearer path over a network has been established. Mid-call or mid-session refers to events that occur once a call session, including the bearer path, has been set up. For at least this reason, claim 1 is not anticipated by Culpepper.

In response to this argument presented by Applicant, the final Office Action stated that the present specification at page 6, lines 10-26, teaches mid-call events, similar to Culpepper. There are two embodiments described in the cited passage. DTMF digits

can be collected before establishing a call or during a call. Specification, page 6, lines 26-27. However, claim 1 refers to one of these embodiments, namely the embodiment in which information requested from the media gateway controller is received *before* establishing a bearer path over a network.

The claim language cannot be ignored in applying the teachings of a reference to the claim. Claim 1 is unambiguous in stating that the information is received before establishing a barrier path over the network. This is distinguished clearly over Culpepper. Culpepper talks about using SIP INFO messages to carry DTMF tones or digits. However, Culpepper is unambiguous in noting that such digits (or other events) are communicated during mid-call (Culpepper, page 1, Abstract), and communicated along a SIP signaling path (Culpepper, page 1, last paragraph). It is clear from this context and from the expressed words of Culpepper itself that the DTMF digits and tones are communicated after a call session has been established--that is, after a bearer path has been established over a network. This contradicts the language of claim 1.

The Office Action cited to page 2, section 2, of Culpepper as teaching a signaling gateway to collect DTMF digits to set up a call before establishing a connection between two end users. Section 2, on page 2, of Culpepper refers to using a SIP INFO message (described in reference [3]) to carry DTMF digits generated *during* a session. This clearly does not satisfy the claim element "receiving the information before establishing a bearer path." Section 2 of Culpepper also refers to reference [5], which teaches the use of a Q.931 Keypad Facility information element to transport DTMF digits collected at a signaling gateway (SG). However, there is absolutely no indication that the signaling gateway referred to *receives* a call request form a first media gateway controller, *requests* information from the first media gateway controller, and *receives* the *requested* information before establishing the bearer path. Therefore, the signaling gateway referenced in Section 2, page 2, of Culpepper does not perform all three of the recited acts.

Moreover, the signaling gateway that receives DTMF digits in the Q.931 Keypad Facility information element is not related to the MGC and SIP entity cited by the final Office Action as performing the call request receiving act and information requesting act of claim 1. 11/14/2003 Office Action at 2. The SIP entity of Culpepper cited by the final

Office Action receives DTMF digits in a SIP INFO method along a signaling path in mid-session. On the other hand, the signaling gateway referenced in section 2, page 2, of Culpepper receives DTMF digits in a Q.931 Keypad Facility information element. These two techniques are completely un-related to each other.

In fact, section 2 of Culpepper, which discusses the signaling gateway (SG), has the heading "Existing DTMF Notification Methods." The document identified as reference [5] in this section of Culpepper is "focused[d] on call set up and tear down." However, the receipt of DTMF digits for call setup and tear down as performed by the signaling gateway (SG) in reference [5] is inconsistent with the technique proposed in Culpepper of using the SIP INFO method in mid-call to convey DTMF digits. Thus, to the extent that the Office Action has identified multiple entities that use different and inconsistent techniques as performing the acts of claim 1, such a construction is clearly improper.

Therefore, claim 1 is allowable over Culpepper. Independent claim 29[1] is similarly allowable over Culpepper.

Claims dependent from independent claims 1 and 29 are allowable over the cited references for at least the same reasons as corresponding independent claims. Moreover, claim 11 (which depends from claim 1), further recites that requesting the information comprises requesting the information in response to determining that additional digits are desired to terminate a call. Neither Culpepper nor Choudhuri teaches or suggests requesting information in response to determining that additional digits are desired to establish the call. Both the proposed technique of Culpepper and the mechanism described in Choudhuri relate to mid-session or mid-call communication of the SIP INFO message for transporting DTMF digits. Both Culpepper and Choudhuri assume that a call has *already* been established--therefore, neither reference would determine that additional digits are desired to establish a call, and requesting information in response to such determining.

With respect to dependent claim 38 (which depends from claim 1), it is respectfully submitted that Culpepper fails to disclose receiving a SIP Invite message

[1] The scope of claim 29 has been broadened by replacing "voice" with "bearer" at line 7.

containing an ISUP Initial Address Message (IAM). The final Office Action cited to the Abstract and to section 1 of Culpepper as teaching this feature--a review of these sections indicates that there is no such teaching of a SIP Invite message containing an ISUP IAM. Also, it is respectfully submitted that Culpepper does not "inherently" disclose that requesting and receiving of information occurs prior to sending a SIP OK message in response to the Invite message. As clearly described in Culpepper, a call session is first established, after which SIP INFO messages can be used to carry various events, including DTMF signaling. To establish a call session, an OK message must first be transmitted in response to an Invite message. Therefore, what Culpepper teaches is the communication of SIP INFO messages *after* the Invite and OK messages have been exchanged.

Claim 39, which depends from claim 1, recites that receiving the information comprises receiving the information in a Session Initiation Protocol Info message prior to establishing a bearer path over the network. Claim 39 recites subject matter that is contradicted by the teachings of Culpepper and Choudhuri, which relate to receiving information in SIP INFO messages communicated along an SIP signaling path in mid-session or mid-call (i.e., after establishment of a bearer path).

Independent claim 12 was rejected as being obvious over the asserted combination of Culpepper and Choudhuri. Claim 12 recites an apparatus that includes a controller to receive a call request from a media gateway controller, to determine if at least one digit is required to *establish a call session*, and to receive the at least digit from the media gateway controller over the packet-based network from the media gateway controller in response to determining that the at least one digit is required.

Note that claim 12 recites determining if a digit is required to *establish* a call session, and to receive such digit for *establishing* a call session from the media gateway controller. This implies that the determining and receiving acts are performed prior to establishment of a call session. As noted above, Culpepper teaches using the SIP INFO message for communicating *mid-call* events in SIP sessions. Choudhuri also describes using SIP INFO messages to perform *mid-session* signaling, Choudhuri at 1-2. Therefore, even if the asserted combination of Culpepper and Choudhuri is proper, such a combination does not teach or suggest determining if a digit is required to establish a call

session and receiving that at least one digit from a media gateway controller in response to determining that the at least one digit is required. Therefore, for at least this reason, the hypothetical combination of Culpepper and Choudhuri does not teach or suggest the claimed invention, and thus, a *prima facie* obviousness rejection has not been properly established with respect to claim 12.

In response to these arguments, the final Office Action adopted the same arguments as provided for claim 1, namely, that Culpepper teaches receiving a digit from a media gateway controller prior to establishing a call session. As noted above, Culpepper is unambiguous in its discussion of its proposed technique that all DTMF tones or digits are carried *during*, not *before*, a call session. The present Office Action has also failed to address Applicant's arguments that Choudhuri also teaches the use of SIP INFO messages to perform mid-session signaling. Thus, both references cited by the Office Action against claim 12 provide teachings that contradict the subject of claim 1. Therefore, the obviousness rejection of claim 12 over Culpepper and Choudhuri is defective and should be withdrawn. A *prima facie* case of obviousness has not been established with respect to claim 12.

Claim 15, which indirectly depends from claim 12, further recites that the controller is adapted to request the at least one digit from the media gateway controller over the packet-based network in response to determining that the at least one digit is required to establish the call session. Contrary to the assertion made in the Office Action, neither Culpepper nor Choudhuri discloses a controller to request the at least one digit from the media gateway controller over a packet-based network in response to determining that the at least one digit is required to establish the call session.

Claim 18, which depends from claim 12, recites that the controller is further adapted to *complete a call session in response to receiving the at least one digit.* The SIP INFO messages exchanged in mid-session described in Culpepper and Choudhuri cannot satisfy this element.

Claim 41, which depends indirectly from claim 12, recites that the controller is adapted to receive at least one digit in a Session Initiation Protocol Info message prior to establishing the call session. This is contradicted by the teachings of Culpepper and Choudhuri.

With respect to dependent claim 42, which depends from claim 41, neither Culpepper nor Choudhuri discloses receiving a digit in a SIP Info message prior to the controller sending a SIP OK message.

Independent claim 20 was also rejected over the asserted combination of Culpepper and Choudhuri. Claim 20 recites that *prior* to a call session being established in response to a call request, a controller is adapted to receive a request to collect digits from a media gateway controller over a packet-based network. As noted above, Culpepper and Choudhuri teach communicating events during (not prior to) call session establishment. Therefore, the hypothetical combination of Culpepper and Choudhuri does not teach or suggest this element. A *prima facie* case of obviousness has thus not been established with respect to claim 20.

Claim 26, which depends from claim 20, recites that the controller is adapted to transmit the digits within a Session Initiation Protocol message prior to the call session being established. The Session Initiation Protocol INFO messages used by Culpepper and Choudhuri are communicated in mid-call or mid-session, that is, after a call session has been established.

Independent claim 37[2] was rejected over the hypothetical combination of Culpepper and BICP. Even if the asserted combination of Culpepper and BICP is proper, such combination does not teach or suggest receiving at least one digit in one of a BICC and Session Initiation Protocol message from a media gateway controller *before* establishing a voice path over a packet-based network. A *prima facie* case of obviousness has thus not been established with respect to the claim.

With respect to claim 44, which depends from claim 37, neither Culpepper nor BICP discloses receiving a digit in a SIP Info message *prior* to establishing a call session in response to an Invite message.

In view of the foregoing, it is respectfully submitted that all claims are in condition for allowance, which action is respectfully requested. The Commissioner is authorized to charge any additional fees, including extension of time fees, and/or credit any overpayment to Deposit Account No. 20-1504 (NORT.0075US).

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[2] The scope of claim 37 has been broadened by replacing the term "voice" with "bearer" at line 6.

Respectfully submitted,

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Dan C. Hu, Reg. No. 40,025
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, TX 77024
713/468-8880 [Ph]
713/468-8883 [Fax]

CUSTOMER NO. 21906